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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,215	02/17/2004	Ray L. Westfall	2004-101A	1931
38382	7590	11/26/2004		EXAMINER
JOHN P. COSTELLO				PAYER, HWEI SIU CHOU
331 J STREET, SUTIE 200				
SACRAMENTO, CA 95814			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

03

Office Action Summary	Application No.	Applicant(s)	
	10/781,215	WESTFALL, RAY L.	
	Examiner	Art Unit	
	Hwei-Siu C. Payer	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11 and 19-21 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 12-18 is/are rejected.
- 7) Claim(s) 8 and 9 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 February 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Restriction/Election

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I (Figs.1-2);

Species II (Fig.3A);

Species III (Fig.3B); and

Species VI (Fig.8).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, some claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. John P. Costeelo on 11-15-2004 a provisional election was made with traverse to prosecute the invention of Species I, claims 1-9 and 12-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10, 11 and 19-21 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims Objection

Claims 2-9 and 12-18 are objected to because of the following informalities:

- (1) In claim 2, line 6, "female end" should read --said female end-- since it refers to the one previously cited.
- (2) In claim 13, line 8, "female end" should read --said female end-- since it refers to the one previously cited.

Appropriate correction is required.

Claims Rejection - 35 U.S.C. 102(b)

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tatar (U.S. Patent No. 5,600,914).

Tatar's implement shows a hollow sheath (20) closed at a first end (see Figs.4 and 5) and open at an opposite female end (26,28); a utensil (34) comprising a utensil end (i.e. the pointed end in the form of a skewer) for interacting with a food item (i.e. a fish, see column 4, lines 46-47) and an opposite male portion (38) for inserting into the female end (26,28) of the sheath (20, see Figs.2 and 4); upon joining the male portion (38) and the female end (26,28), the sheath (20) forming an elongate handle (see Figs.2 and 4) for grasping by a user and manipulating the utensil end as claimed. Further, the sheath (20) comprises an inner hollow longitudinal section (22) for receiving and fully enclosing the utensil end (see Fig.1).

3. Claims 1, 2, 12, 13 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Stephenson (U.S. Patent No. 850,189).

Stephenson's implement shows a hollow sheath (5) closed at a first end (7) and open at an opposite female end (6); a utensil (9) comprising a utensil end (i.e. the pointed end in the form of a knife blade) and an opposite male portion (10) for inserting

into the female end (6) of the sheath (5, see Figs.3 and 4); the female end (6) having an inside diameter sufficient for snugly receiving the male portion (10) therein in a friction fit; upon joining the male portion (10) and the female end (6), the sheath (5) forming an elongate handle for grasping by a user and manipulating the utensil end, and the sheath (5) further comprising an inner hollow longitudinal section for receiving and fully enclosing the utensil end as claimed (see Fig.2). The statement of intended use (i.e. for interacting with a food item) adds no structure to and is of no patentable import in the claimed implement.

Claims Rejection - 35 U.S.C. 103(a)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatar (U.S. Patent No. 5,600,914) in view of Reams (U.S. Patent No. 1,705,205).

Tatar's implement as set forth shows all the claimed structure except for the rotatable hanger.

Reams shows an implement comprising a hanger (4) rotatably coupled a sheath (1) of the implement.

It would have been obvious to one skilled in the art to modify Tatar by providing the sheath with a rotatable hanger to facilitate hanging of the implement with is not in use as taught by Reams.

3. Claims 5-7, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatar (U.S. Patent No. 5,600,914) in view of Lautmann (U.S. Patent No. 2,921,326).

Tatar's implement as set forth shows all the claimed structure except the joining of the male portion (38) and the female end (26,28) is by means of a locking member rather than by friction fit.

Lautmann teaches joining two members (10,11) by press fit (see column 2, lines 55-58). One (10) of the members has a female end (see Fig.3) which opens into an expanded section comprising a larger inside diameter (23) than the remainder of the member (10), the expanded section being diametrically and longitudinally sized to snugly receive a male portion (36) of the other member (11).

It would have been obvious to one skilled in the art to modify Tatar by joining the female end (26,28) and the male portion (38) by press fit to simplify the parts required for joining the two as taught by Lautmann.

It is noted claims 6 and 17 call for the range for the length of the expanded section. To select a certain range such as between $\frac{3}{4}$ " and 3" for the expanded section of the modified Tatar would have been obvious to one having ordinary skill in the art, since it has been held that where the general conditions of a claim are disclosed in the

prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233 (CCPA 1955).

4. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatar (U.S. Patent No. 5,600,914) and Lautmann (U.S. Patent No. 2,921,326) as applied to claim13 above, and further in view of Reams (U.S. Patent No. 1,705,205).

Tatar's implement as modified above shows all the claimed structure except for the rotatable hanger.

Reams shows an implement comprising a hanger (4) rotatably coupled a sheath (1) of the implement.

It would have been obvious to one skilled in the art to further modify Tatar by providing the sheath with a rotatable hanger to facilitate hanging of the implement with is not in use as taught by Reams.

Indication of Allowable Subject Matter

Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art Citations

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Alexander, Martin, Kirby, Wu, Koong and Gillbert, Jr. et al. are cited as art of interest.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hwei-Siu C. Payer whose telephone number is 571-272-4511. The examiner can normally be reached on Monday through Friday, 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for official communications and 703-746-3293 for proposed amendments.

H Payer
November 23, 2004

Hwei-Siu Payer

Hwei-Siu Payer
Primary Examiner